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PATENT APPLICATION
10/039,160

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**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of: Shmuel Shaffer et al.
Serial No. 10/039,160
Filing Date: December 31, 2001
Group Art Unit: 2642
Examiner: Quynh H. Nguyen
Title: METHOD AND SYSTEM FOR CONTROLLING
AUDIO CONTENT DURING MULTIPARTY
COMMUNICATION SESSIONS

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Willie Jiles
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Date: May 17, 2005

Appeal Brief

Appellants have appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed February 18, 2005, finally rejecting Claims 1-50, all of which are pending in this case. Appellants filed a Notice of Appeal on March 17, 2005. Appellants respectfully submit this Appeal Brief with the statutory fee of \$500.00.

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Real Party In Interest

This application is currently owned by Cisco Systems, Inc., as indicated by an assignment recorded on December 31, 2001, in the Assignment Records of the United States Patent and Trademark Office at Reel 012465, Frames 0045-0048.

Related Appeals and Interferences

There are no known appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

Status of Claims

Claims 1-50 are pending in this application. Claims 1-50 are rejected pursuant to a final Office Action mailed November 18, 2004, and are all presented for appeal. All pending claims are shown in Appendix A.

Status of Amendments

All amendments submitted by Appellants were entered by the Examiner before the issuance of the final Office Action mailed November 18, 2004.

Summary of Claimed Subject Matter

Embodiments of the present invention include a technique for controlling audio content during a multiparty communication session that includes prompting active participants in the multiparty communication session to identify themselves. For example, active users may be prompted to identify themselves in response to a request from a participant to the multiparty communication session. Media for a particular device for which no active participant is identified may be disabled to terminate communication of media from the particular device to other devices in the multiparty communication session. A prompt may be played to the particular device for which the media was disabled inviting the participant to re-join the multiparty communication session. At any time and/or in response to a query, a list of active participants may be identified to any of the active participants. *Page 3, lines 11- 31.*

Referring to Figure 1 of the application, a conference bridge 32 may be used to control audio content during a conference call or other suitable multiparty communication session by employing active users to signal their active participation and holding, terminating or otherwise disabling media from inactive users to prevent music and other on-hold content from disrupting an ongoing conference. As a result, active participation of an administrator may not be necessary for a conference and any user may initiate processing to disable media from on-hold endpoints. Thus, participants in a "meet me" conference may eliminate disruptive music-on-hold and users of an ad-hoc conference may remove voice mail and other automated recording systems from participating in a conference. *Page 12, lines 9-23.*

Figure 2 of the application illustrates details of an example conference bridge 32. The example conference bridge includes an on-hold handler 60 that disables on-hold and other disruptive content from an ongoing conference call. In one embodiment, the on-hold handler 60 prompts participants as to whether they are actively participating in a conference call in response to a request by a participant indicating disruptive content is being streamed into the conference call. Users who respond promptly are determined to be active while those who do not respond in time are determined to be on hold. In a particular embodiment, participants may have between five and ten seconds to respond. To recognize DTMF, spoken and/or other responses, the on-hold handler 60 may include DSP, adapted speech recognition and other response recognition resources. *Page 15, line 21 – Page 16, line 2.*

After identifying inactive users, or endpoints on-hold, the on-hold call handler 60 disables media from the on-hold endpoints. The media may be disabled by terminating the endpoint from the conference call, dropping media from the conference call, or holding and/or suspending the call. While media from an endpoint is suspended from entering the call and being provided to other participants of the conference call, the media from the other the participants may nevertheless continue to be provided to the on-hold endpoint. *Page 16, lines 3-13.*

Figure 4 of the application illustrates a method for disabling media from endpoints with inactive participants to a conference call in accordance with one embodiment of the present invention. The method begins at step 100 in which the conference call is established. The conference call may be established by a conference bridge in response to instructions from a call manager. Proceeding to step 102, the conference bridge receives an indication of on-hold content from an endpoint to the conference call. The indication may be a user request for on-hold processing or may be based on analysis of conference call content by the conference bridge. If the indication is based on a user request and validation, or authorization is required, such authorization is performed at step 102. *Page 18, line 19 – Page 19, line 2.*

At step 104 of the method, each participant is prompted to signal active participation in the conference call. At step 106, responses are received from active participants. The method may wait at step 106 for a specified period of time in order to allow all active participants to respond. As previously discussed, the period of time may be between five, ten seconds or other suitable period of time. In a specific embodiment only endpoints that stream voice packets above a threshold energy into the conference bridge are prompted and/or expected to respond. At step 108, devices with inactive participants are identified. In one embodiment, the devices with inactive participants are devices for which a response was requested and from which no response was received. At step 110, media from the devices with inactive participants is disabled. In this way, disruptive music-on-hold content is not streamed into the conference call and/or is removed from the conference call. *Page 19, lines 3-25.*

At step 112, list of participants is updated to indicate the current status of all participants. At step 114, the updated list may be broadcast to the active or other participants. In addition, or alternatively, the participant list may be provided to participants upon request.

Step 114 leads into the end of the process in which users are employed to signal their active participation in a conference call to allow on-hold endpoints to be disabled without administrative intervention. *Page 19, line 26 – Page 20, line 3.*

Grounds of Rejection to be Reviewed on Appeal

Appellants request that the Board review the Examiner's rejection of Claims 1, 5, 7, 8, 12, 14-17, 21, 23, 24, 28, 30-33, 37, 39, 40, 44, 46-48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,415,269 issued to Dinwoodie ("*Dinwoodie*") in view of U.S. Patent No. 4,894,824 issued to Hemmady et al. ("*Hemmady*"). Furthermore, Appellants request that the Board review the Examiner's rejection of Claims 6, 9-11, 22, 25-27, 38, and 41-43 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie* in view of *Hemmady* and further in view of U.S. Patent 6,556,670 issued to Horn ("*Horn '670*"), and the Examiner's rejection of Claims 2-4, 13, 18-20, 29, 34-36, and 45 under 35 U.S.C. 103(a) as being unpatentable over *Dinwoodie* in view of *Hemmady* and further in view of U.S. Patent No. 6,457,045 issued to Hanson et al. ("*Hanson*"). Appellants also request that the Board review the Examiner's rejection of Claim 49 under 35 U.S.C. 103(a) as being unpatentable over *Dinwoodie* and the Examiner's rejection of Claim 50 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,178,237 ("*Horn '237*") in view of *Dinwoodie*.

Argument

The Examiner's rejections of Claims 1-50 is improper, and the Board should withdraw the rejections for the reasons given below.

I. The Examiner's Rejection of Claims 1, 5, 7, 8, 12, 14-17, 21, 23, 24, 28, 30-33, 37, 39, 40, 44, and 46-48 Under 35 U.S.C. § 103(a) Over *Dinwoodie* in View of *Hemmady* is Improper

As noted above, the Examiner rejects Claims 1, 5, 7, 8, 12, 14-17, 21, 23, 24, 28, 30-33, 37, 39, 40, 44, and 46-48 under 35 U.S.C. § 103(a) as being unpatentable over *Dinwoodie* in view of *Hemmady*. In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143.

In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, neither *Dinwoodie* nor *Hemmady* provides a suggestion or motivation to combine these two references. Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Dinwoodie* and *Hemmady*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of independent Claims 1, 17, and 33.

A. No Motivation or Suggestion to Combine *Dinwoodie* and *Hemmady*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or

implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an Appellant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W. L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added).²

¹ Note M.P.E.P. 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the

In the present case, the Examiner is improperly using the Appellant's disclosure as a blueprint for piecing together various elements of *Dinwoodie* and *Hemmady*. For example, in the Final Office Action, the Examiner merely asserts that it would have been obvious “to incorporate the feature of timing out the connection request if no acknowledgement is received to identify as active link or active participant, as taught by *Hemmady*, in *Dinwoodie*’s system, in order to save system resource and avoid the link or port being tied up.” The Examiner goes on to state that “it would be beneficial if the system periodically checks for active participant, if no response from the participant indicating that the participant is not active and disabling the media form that particular inactive participant to allow other callers to joint the conference.” *Final Office Action*, p. 3.

First, the Examiner fails to identify how the feature of timing out a *connection request* from a “MINT” in a data network of *Hemmady* is in any way related to the disabling of media from a device in a multiparty communication session (as recited in Claims 1, 17 and 33). Furthermore, the Examiner fails to describe how the timing out of a connection request from a MINT, as disclosed in *Hemmady*, could in any manner be combined with any particular teaching of *Dinwoodie*. These two references are completely unrelated and there is absolutely no reasoning given by the Examiner as to how the specific teachings of these two references could be combined even if there was a suggestion to combine, which there clearly is not. All the Examiner has provided is a statement that modifying *Dinwoodie* (in a way not that is not described by the Examiner) to perform the steps of the present invention (which the Examiner is evaluating in *hindsight*) would be “beneficial.” Nowhere does *Dinwoodie* or *Hemmady* disclose, teach, or suggest the need for a system that “disabl[es] media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” Thus, the suggestion or motivation required by M.P.E.P. § 2143.01 for the proposed combination of *Dinwoodie* and

herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

Hemmady does not exist, and the Examiner has failed to identify the source of such suggestion or motivation.

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1, 17, or 33 (or the claims that depend from these independent claims), as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references. For at least this reason, Appellant respectfully requests reconsideration and allowance of Claims 1, 17, or 33 (and the claims that depend from these independent claims).

B. *Dinwoodie* and *Hemmady* Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 1, 17, and 33

Even assuming for the sake of argument that the cited references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Dinwoodie* and *Hemmady*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, would still fail to disclose each and every element of Claims 1, 17, and 33.

For example, Independent Claim 1 recites the following:

A method for controlling audio content during a multiparty communication session, comprising:
 establishing a multiparty communication session involving a plurality of participants, each participant associated with a device;
 after establishing the multiparty communication session, prompting the participants to identify themselves as active participants; and
 disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

Claims 17 and 33 recite similar, although not identical, limitations.

Among other aspects of Claim 1, *Dinwoodie* and *Hemmady* fail to describe “after establishing the multiparty communication session, prompting the participants to identify themselves as active participants.” For an alleged teaching of this limitation, the Examiner cites to a portion of *Dinwoodie* discussing a series of steps a bidder must take before commencement of an auction and before being linked to an auction site. However, *Dinwoodie* merely discloses that when a caller wishes to be linked to an auction site, the caller must enter an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller is prompted to enter the password, PIN, and bidder number, the caller still has not linked to the auction site, let alone participated in an established “multiparty communication session involving a plurality of participants.” When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not participated in the auction or any multiparty communication session at the time he or she is prompted to enter the requested information. Thus, *Dinwoodie* fails to describe “*after* establishing the multiparty communication session, prompting the participants to identify themselves as *active* participants.”

After seemingly arguing that *Dinwoodie* does disclose this limitation in the Final Office Action, the Examiner then seems to agree in the next paragraph that *Dinwoodie* does not disclose this limitation (the Examiner states that “*Dinwoodie* does not teach after establishing the multiparty communication session, the participants identify themselves as active participants . . .”). As noted above, Claim 1 (and similarly Claims 17 and 33) requires that “after establishing the multiparty communication session, prompting the participants to identify themselves as active participants.” Therefore, the claim requires that the *prompting* occurs after establishing the multiparty communication session has been established. The Examiner has provided no argument as to how *Dinwoodie* discloses any prompting of *active* participants *after* establishing the multiparty communication session, as described above.

Furthermore, there is also no disclosure of such prompting in *Hemmady*. The Examiner argues that Column 25, line 58 through Column 26, line 8 of *Hemmady* discloses

this limitation. This passage discloses that if a *connection request* by a MINT is ignored or not acknowledged within a pre-specified time then the MINT times out. Applicants fail to see how this discloses “*after* establishing the multiparty communication session, prompting the participants to identify themselves as *active* participants.” As with *Dinwoodie*, there is no concept in this reference relating to the establishment of a multiparty communication session and then prompting the participants of the already-established multiparty communication session to identify themselves as active participants,” as required by Claim 1.

In fact, in the Advisory Action, the Examiner appears to acknowledge that neither *Dinwoodie* nor *Hemmady* disclose this limitation since the Examiner states that “prompting the active participants to identify themselves after establishing the communication session is well known and the advantage of using it is also well known.” Therefore, it appears the Examiner is now relying (at least in part) on unspecified prior art to disclose this limitation. The Examiner cannot simply rely on a general statement that a limitation is “well known.” If the Examiner is relying on “common knowledge” or “well known” art to provide the missing limitations, the Examiner must produce a reference in support of his position as required by M.P.E.P. § 2144.03. Otherwise, if the Examiner is relying on personal knowledge to supply the required teachings, the Examiner must produce an affidavit supporting such facts as required by M.P.E.P. § 2144.03. Since such a reference or affidavit has not been provided and since neither *Dinwoodie* nor *Hemmady* disclose this limitation, Appellants respectfully request allowance of Claims 1, 17, and 33.

Furthermore, *Dinwoodie* also fails to describe “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” The Examiner appears to recognize that *Dinwoodie* does not disclose this limitation (see last paragraph of page 2 of the Final Office Action); however, the Examiner also argues in the second to last paragraph on page 2 that it does. *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, Col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the

auction site and therefore has not participated in the auction, let alone communicated media to other devices in a multiparty communication session. Thus, in *Dinwoodie* there is no “particular device previously used by one of the participants” from which to disable media. Furthermore, there is no “communication of the media from the particular device to other devices in the multiparty communication session” to be terminated. For at least these reasons, *Dinwoodie* fails to describe “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.”

Moreover, *Hemmady* also fails to disclose this limitation. The Examiner argues in the Final Office Action that “Hemmady et al. teach if a connection request by the data switches MINTs 11 is ignored or no acknowledgement of a request or the connection is up and active received within a prespecified time, the MINTs time out or disable the connection request.” This disclosure of the functionality of a MINT does not disclose, teach, or suggest “disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.” First, there is simply no disclosure of identification of active participants in a multiparty communication session. *Hemmady* doesn’t even mention participants in a multiparty communication session, much less identification of active participants.

Also, there is no disclosure in *Hemmady* of disabling media from a device for which no active participant is identified. It appears that the Examiner is asserting that the timing out of a connection *request* is a disclosure of the disabling of media from a device for which no active participant is identified; however, this would require equating a device that was participating in a multiparty communication session and for which an active participant is no longer identified (as disclosed in the present application) to a MINT (as disclosed in *Hemmady*). A MINT is a memory interface module that is part of a metropolitan network and that send connection requests. There is no disclosure that a MINT is a device participating in a multiparty communication from which media is communicated to other

devices in the multiparty communication session. Further, even if one were to (for the sake of argument) equate a MINT with one of the claimed devices participating in a multiparty communication session, the MINT terminates its *own* connection *request* if no response to the request is received. This is unlike the present claims where an actual communication (an established connection – not a request) is disabled from a previously participating device by some external device (like the system recited in Claim 33) when that external device is unable to identify an active participant at the previously participating device. This is clearly different than a device timing out (terminating) its own connection *request* when it receives no response to the request.

For at least these reasons, Appellants respectfully request allowance of independent Claim 1. For analogous reasons, Appellants respectfully request allowance of independent Claims 17 and 33. Claims 2-16, 18-32, and 34-48 depend from Claims 1, 17, and 33, respectively. Thus, at least because they depend from independent claims shown above to be allowable, Appellants also respectfully request allowance of Claims 2-16, 18-32, and 34-48.

II. The Examiner's Rejection of Claims 6, 9-11, 22, 25-27, 38, and 41-43 Under 35 U.S.C. § 103(a) Over *Dinwoodie* in View of *Hemmady* and *Horn '670* is Improper

As noted above, the Examiner rejects Claims 6, 9-11, 22, 25-27, 38, and 41-43 under 35 U.S.C. §103(a) as being unpatentable by *Dinwoodie* in view of *Hemmady* and in further view of *Horn '670*. As described above, there is no suggestion to combine *Dinwoodie* and *Hemmady*, and thus there is no suggestion to combine *Dinwoodie*, *Hemmady* and *Horn '670*. Furthermore, Claims 6, 9-11, 22, 25-27, 38, and 41-43 each depend from one of Claims 1, 17, or 33. As described above, neither *Dinwoodie* nor *Hemmady* disclose, teach or suggest all the limitations of Claims 1, 17 or 33. Furthermore, *Horn '670* does not provide a disclosure of these missing limitations. Therefore, for the reasons given above with respect to Claims 1, 17, and 33, Appellants respectfully request allowance of Claims 6, 9-11, 22, 25-27, 38, and 41-43.

III. The Examiner's Rejection of Claims 2-4, 13, 18-20, 29, 34-36, and 45 Under 35 U.S.C. § 103(a) Over *Dinwoodie* in View of *Hemmady* and *Hanson* is Improper

As noted above, the Examiner rejects Claims 2-4, 13, 18-20, 29, 34-36, and 45 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie* in view of *Hemmady* and in further view of *Hanson*. As described above, there is no suggestion to combine *Dinwoodie* and *Hemmady*, and thus there is no suggestion to combine *Dinwoodie*, *Hemmady* and *Hanson*. Furthermore, Claims 2-4, 13, 18-20, 29, 34-36, and 45 each depend from one of Claims 1, 17, or 33. As described above, neither *Dinwoodie* nor *Hemmady* disclose, teach or suggest all the limitations of Claims 1, 17 or 33. Furthermore, *Hanson* does not provide a disclosure of these missing limitations. Therefore, for the reasons given above with respect to Claims 1, 17, and 33, Appellants respectfully request allowance of Claims 2-4, 13, 18-20, 29, 34-36, and 45.

IV. The Examiner's Rejection of Claim 49 Under 35 U.S.C. § 103(a) Over *Dinwoodie* is Improper

As noted above, the Examiner rejects Claim 49 under 35 U.S.C. §103(a) as being unpatentable over *Dinwoodie*. Claim 49 recites the following:

A method for handling on-hold endpoints in a conference call, comprising:
 receiving an audio stream from each of a plurality of participants to a conference call;
 receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint;
 prompting each participant to send a reply to a prompt;
 receiving replies from active participants to the conference call; and
 terminating media from devices associated with each participant not sending a reply.

The Examiner concedes that *Dinwoodie* fails to teach or suggest “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-

hold content from at least one on-hold endpoint.” However, the Examiner states in the Final Office Action that “[p]utting the conference call on-hold by the participant is well known.” *Id.* However, the Examiner did not indicate in the Final Office Action that “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint” is well known in the prior art, or that this limitation is disclosed by *Dinwoodie* or any other reference. In the Advisory Action, the Examiner asserts that this limitation is taught by U.S. Patent No. 6,628,768 to Ramaswamy (“*Ramaswamy*”). First, the addition of this additional reference to the rejection is improper in an Advisory Action (it would not even be proper in a final office action since this claim has not been amended). Second, the cited passage of *Ramaswamy* does not disclose the relevant limitation. The passage only discloses putting a conference call on hold, not “receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint.” Appellants therefore respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Furthermore, Appellants respectfully submit that *Dinwoodie* fails to teach or suggest “receiving replies from active participants to the conference call.” As discussed above with regard to Claim 1, *Dinwoodie* discusses a series of steps a bidder must take before being linked to an auction site and before commencement of an auction. The steps include entering an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller enters the password, PIN, and bidder number, the caller still has not actively participated in the auction, let alone in a conference call. When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not actively participated in the auction or any conference call at the time he or she enters the requested information. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not actively participated in the auction, let alone in a conference call. For at least these reasons,

Dinwoodie fails to teach or suggest “receiving replies from active participants to the conference call.”

In addition, Appellants respectfully submit that *Dinwoodie* fails to teach or suggest “terminating media from devices associated with each participant not sending a reply.” As discussed above with regard to Claim 1, *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone communicated media in a conference call. Thus, in *Dinwoodie* there is no media to be terminated. For at least this reason, *Dinwoodie* fails to teach or suggest “terminating media from devices associated with each participant not sending a reply.”

For at least all of these reasons, Appellants respectfully request the Examiner to reconsider and withdraw the rejection of Claim 49.

V. The Examiner’s Rejection of Claim 50 Under 35 U.S.C. § 103(a) Over *Horn* ‘237 in View of *Dinwoodie* is Improper

As noted above, the Examiner rejects Claim 50 under 35 U.S.C. §103(a) as being unpatentable over *Horn* ‘237 in view of *Dinwoodie*. Claim 50 recites:

A conference bridge, comprising:
an input buffer operable to receive and buffer audio streams generated by participants of a multiparty communication session;
a cross-connect operable to cross-connect an audio stream from each participant to conference output stream generators for remaining participants;
the conference stream output generator for each participant operable to combine each audio stream received from the cross-connect multiple independently controlled by the participant and to generate a conference output stream for the participant;

an output buffer operable to receive and buffer the conference output streams for transmission to the participant;
and

an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants.

Among other aspects of Claim 50, the combination of *Horn* '237 in view of *Dinwoodie* fails to teach or suggest "an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants." The Examiner concedes that *Horn* '237 fails to teach or suggest this claim element. Instead, the Examiner cites to a portion of *Dinwoodie* discussing a series of steps a bidder must take before commencement of an auction and before being linked to an auction site. However, as discussed above with regard to Claims 1 and 49, *Dinwoodie* merely discloses that when a caller wishes to be linked to an auction site, the caller must enter an acceptable password, PIN, and bidder number. *Dinwoodie*, col. 4, ll. 2-38. Only after successfully entering all of the required information is the caller linked to the auction site. *Id.*, col. 4, ll. 39-41. Thus, according to the disclosure of *Dinwoodie*, at the time the caller communicates the password, PIN, and bidder number, the caller still has not participated in the auction, let alone in a multiparty communication session. When the caller enters the requested information the caller is merely *attempting* to link to the auction site. Therefore, the caller in *Dinwoodie* has not participated in the auction or any multiparty communication session at the time he or she is prompted to enter the requested information. *Dinwoodie* specifically discloses that a caller must submit acceptable information prior to being permitted to participate in an auction. *Dinwoodie*, col. 4, ll. 39-41. Thus, at the time the caller submits the requested information, the caller has not participated in the auction, let alone in a multiparty communication session. For at least these reasons, *Dinwoodie* fails to teach or suggest "an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants."

Furthermore, *Dinwoodie* also fails to teach or suggest "an on-hold handler operable in response to a participant request to communicate with the participants . . . and to disable

audio streams generated by devices associated with non-active participants.” *Dinwoodie* describes terminating a telephone call when the caller fails to input an acceptable password, PIN, or bidder number. *Dinwoodie*, col. 4, lines 2-38. At the time the call is terminated, indeed because the call is terminated, the caller has not linked to the auction site and therefore has not participated in the auction, let alone generated audio streams. Thus, in *Dinwoodie* there are no “audio streams generated by devices associated with non-active participants” to be disabled. For at least these reasons, *Dinwoodie* fails to describe “an on-hold handler operable in response to a participant request to communicate with the participants . . . and to disable audio streams generated by devices associated with non-active participants.”

In addition, Appellants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Horn* ‘237 and *Dinwoodie* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must point to some teaching, suggestion, or motivation in the prior art to combine or modify references to produce the claimed invention. M.P.E.P. §2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis in original). Thus, the mere assertion that the teachings of one reference might improve the teachings of another reference, as the Examiner states, does not provide the required suggestion to combine. Moreover, nothing in *Horn* ‘237 or *Dinwoodie* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. The fact, as pointed out by the Examiner in the Advisory Action, that the two references relate to the same general topic (“conferencing”) and are in the same PTO classification is not enough. For this additional reason, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness and request allowance of Claim 50.

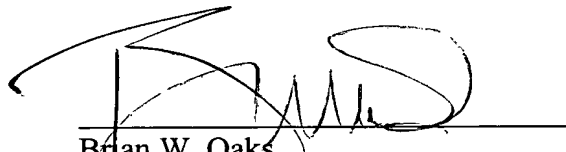
Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Appellants have enclosed a check in the amount of \$500.00 for this Appeal Brief. Appellant believes no additional fees are due. The Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Appendix A: Claims on Appeal

1. (Previously Presented) A method for controlling audio content during a multiparty communication session, comprising:

establishing a multiparty communication session involving a plurality of participants, each participant associated with a device;

after establishing the multiparty communication session, prompting the participants to identify themselves as active participants; and

disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

2. (Previously Presented) The method of Claim 1, further comprising prompting the participants to identify themselves in response to at least a request from one of the participants.

3. (Previously Presented) The method of Claim 2, further comprising authenticating the request.

4. (Original) The method of Claim 3, wherein authenticating the request comprises authenticating the participant making the request.

5. (Original) The method of Claim 1, further comprising disabling media from each device from which no active participant is identified.

6. (Original) The method of Claim 1, wherein the disabled media comprises on-hold content.

7. (Previously Presented) The method of Claim 1, further comprising receiving a response to the prompt from at least one participant via a dual-tone multi-frequency (DTMF) command.

8. (Previously Presented) The method of Claim 1, further comprising utilizing adaptive speech recognition to identify responses from participants.

9. (Previously Presented) The method of Claim 1, further comprising filtering out responses to the prompt to prevent communication of the responses to the other devices in the multiparty session.

10. (Original) The method of Claim 1, further comprising periodically playing to the particular device for which the media is disabled a prompt inviting the participant to re-join the multiparty communication session.

11. (Original) The method of Claim 10, further comprising enabling media from the particular device in response to at least receiving a re-join request from the particular device.

12. (Original) The method of Claim 1, further comprising identifying to the active participants a list of the active participants.

13. (Original) The method of Claim 12, further comprising identifying the list of active participants to a particular active participant in response to a query by the particular active participant.

14. (Original) The method of Claim 1, wherein each active participant identifies himself with a secure signal.

15. (Original) The method of Claim 14, wherein the secure signal comprises a password.

16. (Original) The method of Claim 1, further comprising:
determining devices connected to the multiparty communication session streaming voice packets; and
disabling media from each device streaming voice packets and from which no active participant is identified.

17. (Previously Presented) A system for controlling audio content during a multiparty communication session, comprising:

means for establishing a multiparty communication session involving a plurality of participants, each participant associated with a device;

means for, after establishing the multiparty communication session, prompting the participants to identify themselves as active participants; and

means for disabling media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

18. (Previously Presented) The system of Claim 17, further comprising means for prompting the participants to identify themselves in response to at least a request from one of the participants.

19. (Previously Presented) The system of Claim 18, further comprising means for authenticating the request.

20. (Original) The system of Claim 19, wherein the means for authenticating the request comprises means for authenticating the participant making the request.

21. (Original) The system of Claim 17, further comprising means for disabling media from each device from which no active participant is identified.

22. (Original) The system of Claim 17, wherein the disabled media comprises on-hold content.

23. (Previously Presented) The system of Claim 17, further comprising means for receiving a response to the prompt from at least one participant via a dual-tone multi-frequency (DTMF) command.

24. (Previously Presented) The system of Claim 17, further comprising means for utilizing adaptive speech recognition to identify responses from participants.

25. (Previously Presented) The system of Claim 17, further comprising means for filtering out responses to the prompt to prevent communication of the responses to the other devices in the multiparty session.

26. (Original) The system of Claim 17, further comprising means for periodically playing to the particular device for which the media is disabled a prompt inviting the participant to re-join the multiparty communication session.

27. (Original) The system of Claim 26, further comprising means for enabling media from the particular device in response to at least receiving a re-join request from the particular device.

28. (Original) The system of Claim 17, further comprising means for identifying to the active participants a list of the active participants.

29. (Original) The system of Claim 28, further comprising means for identifying the list of active participants to a particular active participant in response to a query by the particular active participant.

30. (Original) The system of Claim 17, wherein each active participant identifies himself with a secure signal.

31. (Original) The system of Claim 30, wherein the secure signal comprises a password.

32. (Original) The system of Claim 17, further comprising:
- means for determining devices connected to the multiparty communication session streaming voice packets; and
 - means for disabling media from each device streaming voice packets and from which no active participant is identified.

33. (Previously Presented) A system for controlling audio content during a multiparty communication session, comprising media encoded in logic and operable to:

establish a multiparty communication session involving a plurality of participants, each participant associated with a device;

after establishing the multiparty communication session, prompt the participants to identify themselves as active participants; and

disable media from a particular device previously used by one of the participants and from which no active participant is identified to terminate communication of the media from the particular device to other devices in the multiparty communication session.

34. (Previously Presented) The system of Claim 33, the logic further operable to prompt the participants to identify themselves in response to at least a request from one of the participants.

35. (Previously Presented) The system of Claim 34, the logic further operable to authenticate the request.

36. (Original) The system of Claim 35, the logic further operable to authenticate the request by authenticating the participant making the request.

37. (Original) The system of Claim 33, the logic further operable to disable media from each device from which no active participant is identified.

38. (Original) The system of Claim 33, wherein the disabled media comprises on-hold content.

39. (Previously Presented) The system of Claim 33, the logic further operable to receive a response to the prompt from at least one participant via a dual-tone multi-frequency (DTMF) command.

40. (Previously Presented) The system of Claim 33, the logic further operable to utilize adaptive speech recognition to identify responses from participants.

41. (Previously Presented) The system of Claim 33, the logic further operable to filter out responses to the prompt to prevent communication of the responses to the other devices in the multiparty session..

42. (Original) The system of Claim 33, the logic further operable to periodically play to the particular device for which the media is disabled a prompt inviting the participant to re-join the multiparty communication session.

43. (Original) The system of Claim 42, the logic further operable to enable media from the particular device in response to at least receiving a re-join request from the particular device.

44. (Original) The system of Claim 33, the logic further operable to identify to the active participants a list of the active participants.

45. (Original) The system of Claim 44, the logic further operable to identify the list of active participants to a particular active participant in response to a query by the particular active participant.

46. (Original) The system of Claim 33, wherein each active participant identifies himself with a secure signal.

47. (Original) The system of Claim 46, wherein the secure signal comprises a password.

48. (Original) The system of Claim 33, the logic further operable to:
determine devices connected to the multiparty communication session streaming
voice packets; and
disable media from each device streaming voice packets and from which no active
participant is identified.

49. (Original) A method for handling on-hold endpoints in a conference call, comprising:

- receiving an audio stream from each of a plurality of participants to a conference call;
- receiving a control signal from a participant to the conference call indicating the conference call is receiving on-hold content from at least one on-hold endpoint;
- prompting each participant to send a reply to a prompt;
- receiving replies from active participants to the conference call; and
- terminating media from devices associated with each participant not sending a reply.

50. (Previously Presented) A conference bridge, comprising:

- an input buffer operable to receive and buffer audio streams generated by participants of a multiparty communication session;
- a cross-connect operable to cross-connect an audio stream from each participant to conference output stream generators for remaining participants;
- the conference stream output generator for each participant operable to combine each audio stream received from the cross-connect multiple independently controlled by the participant and to generate a conference output stream for the participant;
- an output buffer operable to receive and buffer the conference output streams for transmission to the participant; and
- an on-hold handler operable in response to a participant request to communicate with the participants, to identify active participants and to disable audio streams generated by devices associated with non-active participants.

Appendix B: Evidence

NONE

Appendix C: Related Proceedings

NONE